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DATE: February 9, 2009

PTO IDENTIFIER: Application Number 09/273,567
Patent Number RE36,770

Inventor: Dante E. PICCONE

MESSAGE TO: US Patent and Trademark Office (Attn: Office of Petitions)

FAX NUMBER: (571) 273-8300

FROM: BLANK ROME LLP
Michael C. Greenbaum

PHONE: (202) 772-5800

Attorney Dkt. #: 105773.0132

PAGES (Including Cover Sheet): 21

CONTENTS: Petition for Reconsideration (37 C.F.R. 1.378(b))
(with Statement of Andrew Yost, Copy of Decision, Copy of Letter dated November 30, 2000,
reporting Letters Patent & Copy of Maintenance Fee Transmittal and Return Receipt dated
August 27, 2004)
Certificate of Transmission (1 page)

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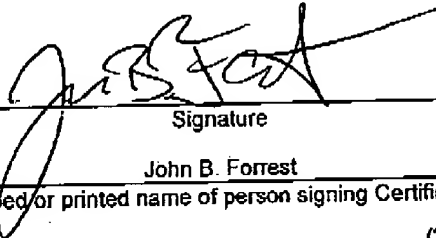
Application No. (if known): 09/273,567

Attorney Docket No.: 105773.0132

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office.

on February 9, 2009
Date



Signature

John B. Forrest

Typed or printed name of person signing Certificate

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Telephone Number

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Petition for Reconsideration (37 C.F.R. 1.378(b))
(with Statement of Andrew Yost, Copy of Decision, Copy of Letter dated November 30, 2000, reporting Letters Patent & Copy of Maintenance Fee Transmittal and Return Receipt dated August 27, 2004)

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Docket No.: 105773.0132
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Dante E. PICCONE

Original Patent No.: 5,614,737

Patent No.: RE36770

Original Issue Date: March 25, 1997

Reissued: July 11, 2000

Application No.: 09/273,567

For: MOS-CONTROLLED HIGH-POWER
THYRISTOR

Filed: March 22, 1999

PETITION FOR RECONSIDERATION UNDER 37 C.F.R. § 1.378(B)

Attention: Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present Petition for Reconsideration is filed in response to the Decision on Petition mailed December 8, 2008 (hereinafter referred to as the "PTO Decision"). A copy of the Decision is attached hereto. The Petitioner respectfully requests reconsideration in light of the additional information provided herein, which shows that the Petitioner exercised the standard of care observed by a reasonable person in the conduct of that person's most important business and that the delay in paying the maintenance fee was therefore unavoidable. The undersigned hereby authorizes and requests the Office to charge the required petition fee of \$400.00 under 37 CFR 1.17(h) to Deposit Account No. 23-2185.

The PTO Decision denied the Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent, which was filed September 25, 2008 (hereinafter referred to as "Petition"). The PTO Decision was based on the following reasons: (1) that the Petition

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failed to attribute the error to any employee in particular; (2) that the Petition only had sparse details; (3) that a statement is required from all persons with direct knowledge; and (4) that the Petition does not explain why the firm hadn't noticed why the patent had been expired for six years. (See PTO Decision, pp. 4-5.) A detailed response is provided below. In addition, a Statement by Andrew Yost is being filed herewith in support of the present Petition for Reconsideration (hereinafter referred to as "Reconsideration Statement").

Issue 1: Failure to Identify a Particular Person

The PTO Decision indicates that the Petition failed to attribute the error to any employee in particular. (See PTO Decision, p. 4.) As stated in the current Reconsideration Statement, the firm's Docketing Manager at the time was Lynda Bynum-Cosby. (See Reconsideration Statement, ¶8.) Ms. Cosby had been with the firm for one year at that time, and had five years of previous docketing and supervisory experience, and an additional three years of experience as an IP Specialist. (See Reconsideration Statement, ¶8.) Accordingly, reliance on Ms. Cosby represented the exercise of due care.

Issue 2: Comprehensive and Exhaustive Evidence

The PTO Decision indicates that any renewed petition must be accompanied by comprehensive and exhaustive evidence that a clerical error resulted in the unavoidable delay in paying the 3.5-year maintenance fee. The Reconsideration Statement provides additional detail that supports the inevitable conclusion that the delay was due to clerical error, as well as that the delay was unavoidable as a result of that clerical error. (See Reconsideration Statement, ¶21.)

Issue 3: Statement Required from All Persons with Direct Knowledge

The PTO Decision indicates that a statement is required from employee charged with handling the payment of the maintenance fee, who has first-hand knowledge of the

circumstances that resulted in the delay. (See PTO Decision, p. 4.) The Reconsideration Statement submitted with this Request for Reconsideration is by Mr. Andrew Yost. Though Mr. Yost was not employed by the firm at the time of the facts, he has reviewed the relevant documents and information entered into the firm's docketing software. Accordingly, his statement is made on the direct knowledge obtained from those documents, such as the docket record for the patent at issue, a copy of which was attached to his prior statement. (See prior Statement dated Sept. 25, 2008, ¶10.) It is noted, however, that although Ms. Cosby was employed by the firm for about 7.5 years, she is no longer employed by the firm. (See Reconsideration Statement, ¶8.)

Issue 4: Not Discovering the Patent Being Expired

The PTO Decision requests information as to why the Petitioner had not discovered that the patent was expired for six years, and questions whether the firm had contacted the PTO to determine the status of the patent. (See PTO Decision, p. 5.) Based on information and belief, the 7.5 maintenance fee was paid by facsimile within the open period for the payment. (See Maintenance Fee Facsimile.) Accordingly, there was no reason to expect that the payment would be denied, and therefore no reason to check to see if the payment was not accepted. It is respectfully submitted, therefore, that the PTO's assertion that it would be reasonable for the Petitioner to confirm the payment was accepted, is improper and that Petitioner's actions were consistent with the treatment of the maintenance as Petitioner's most important business.

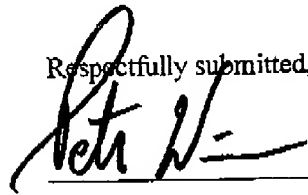
The undersigned hereby reaffirms earlier authorization and request to the Office to charge any outstanding petition fees, maintenance fees, and surcharges to Deposit Account No. 23-2185 necessary to restore this patent to granted status. This authorization and request to charge includes the \$400.00 petition fee required by 37 CFR 1.17(h). Authorization to charge

the 11.5 year maintenance fee to Deposit Account No. 23-2185 was originally provided on September 25, 2008.

For the reasons set forth above, Petitioner respectfully requests reconsideration of the Decision on Petition.

Dated: February 9, 2009

Respectfully submitted,

 (40224) for

Michael C. Greenbaum
Registration No. 28,419

Blank Rome LLP
600 New Hampshire Ave., NW
Washington, DC 20037
(202) 772-5800

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Docket No.: 105773.0132
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Dante E. PICCONE

Original Patent No.: 5,614,737

Patent No.: RE36770

Original Issue Date: March 25, 1997

Reissued: July 11, 2000

Application No.: 09/273,567

For: MOS-CONTROLLED HIGH-POWER
THYRISTOR

Filed: March 22, 1999

STATEMENT IN SUPPORT OF PETITION FOR
RECONSIDERATION UNDER 37 C.F.R. § 1.378(B)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of a Petition for Reconsideration under 37 C.F.R. § 1.378(b). The statements contained herein are based on my IP experience, knowledge of the docketing and maintenance fee systems of Blank Rome LLP and review of the maintenance fee file for the subject patent.

The undersigned hereby states that:

1. I am the IP Administrator at Blank Rome LLP and in that capacity I am responsible for overseeing the administration of all aspects of the patent prosecution practice, including the Docketing Department and monitoring of maintenance fee due dates and payments.
2. I have worked as the IP Administrator at Blank Rome LLP for 10 months, have an additional 8 years of experience as an IP Administrator and an additional 7 years of experience in IP law.
3. I am the person most familiar with the facts regarding the Request for Reconsideration filed herewith and the initial Petition filed September 25, 2008.

4. The IP Group of Blank Rome employs 15-20 attorneys practicing patent prosecution, obtained 188 patents for clients in 2000, the year in which the initial error occurred, and is presently responsible for over 4,000 U.S. applications and patents (including provisional, non-provisional, design and international applications filed with the U.S. Receiving Office) and docketing related thereto, including monitoring maintenance fee due dates and payments for 1,687 issued patents. In view of the number of applications and maintenance fees handled by the firm, on rare occasions clerical and human errors will result in docketing errors.

5. The firm's system for attending to the payment of maintenance fees, as it was in place at the time when the error occurred, operates as follows. The firm uses Thomson Master Data Center's IPMaster™ docketing software to maintain its case records and track due dates. When the firm first receives official notice of a grant date and patent number, normally upon receipt of the official Issue Notification, a docketing clerk enters this information into the case record in the grant date field. When that field is populated, i.e., the grant date is entered, the software automatically calculates and enters into the case record the first, second, and third U.S. maintenance fee due dates. In addition, the docketing clerk manually confirms and enters the first U.S. maintenance fee due date in the "actions" tab of the software.

6. The firm's system includes a software add-on maintenance fee program developed by Mind's Eye Development, which interfaces with our basic docketing software. The module containing this add-on software provides a maintenance fee clerk with an independent tracking mechanism for maintenance fees, as well as for generating client reminder and instruction acknowledgement letters.

7. All of the above entries, automatic and manual, are revisited and reconfirmed when an original Letters Patent is received. The docketing aspects of the firm's maintenance fee payment system are thus believed to be sound, securely redundant, effective, and worthy to be relied upon to track our most important business.

8. At the time when the error occurred, the work associated with payment of maintenance fees was performed under the direct control and close supervision of Linda Bynum-Cosby, the firm's Docketing Manager. At the time of the initial error in 2000, Linda Bynum-Cosby had been with the firm for one year, having five years previous docketing and supervisory experience and an additional three years of experience as an IP specialist. Linda Bynum-Cosby was employed at Blank Rome LLP from February 24, 1999, to August 10, 2006.

9. In addition to the Docketing Manager and the docketing clerks, under the firm's maintenance fee system at the time of the error, a maintenance fee clerk was assigned to report to the Docketing Manager to be trained to assume working responsibility for the following set of highly structured tasks: creating and assembling the maintenance fee file (with a copy of the patent face and any maintenance-fee-related correspondence); initiating system generation of client reminder letters through the maintenance fee module software; receiving and tracking receipt of client instructions (to pay or not to pay the maintenance fee); making sure that the Docketing Department was in possession of the client instructions by the due date for docket clearing purposes; initiating generation of instruction acknowledgement letters (and invoices, where applicable) to the client through the add-on maintenance fee module; where the client instructions were to pay, preparing the maintenance fee transmittal and obtaining the necessary check or credit card authorization form from the firm's Accounting Department; and obtaining attorney signature and submitting the signed documents and fees to the Docketing Manager for review and hand delivery (by the firm's appointed courier) or facsimile transmission to the U.S. Patent and Trademark Office. In view of the number of maintenance fees tracked and paid by the firm, it is not the firm's practice to monitor maintenance fee statements and deposit account activity for maintenance fees believed to be paid on time.

10. From the beginning of the assignment of duties, the maintenance fee clerk performed these tasks only under strict supervision and in constant consultation with the Docketing Manager, at the time of the error Linda Bynum-Cosby. This apprenticeship-like relationship with the Docketing Manager was maintained throughout the tenure of each maintenance fee clerk.

11. Under the firm's system and Linda Bynum-Cosby's tutelage, it was stressed that not only were anomalies, inconsistencies, questions and the like to be resolved prior to taking action, but the docket record indications in general were to be reconciled with the maintenance fee files as soon as possible and definitely before any due date was cleared from the docket.

12. To secure this safeguard, the maintenance fee clerk was required to make sure that the Docketing Department was in possession of the client's instructions required to clear the docket so that the maintenance fee file information would always be added to the electronic file record to ensure the docket was cleared based on a complete and correct record, any discrepancies having been resolved and removed expeditiously.

13. At the time the error occurred, separate maintenance fee files were kept in addition to the firm's main prosecution files in order to streamline and simplify the maintenance fee tracking and payment process and its associated recordkeeping. All and only maintenance-fee-related documents were kept in those files. Also, unlike the firm's general prosecution files, maintenance fee files were created, maintained and stored by and in the maintenance fee clerk's file cabinets. All firm maintenance fee clerks are therefore intimately familiar with these files and aware that reference to them is essential for any information and instructions relating to maintenance fee payment (or nonpayment) in any given case.

14. The above shows that the firm established and maintained reasonable safeguards to ensure that the maintenance fee clerks had ready access to all pertinent information in the payment of maintenance fees and that the firm took all reasonable precautions to ensure that the maintenance fees would be timely paid. The above-described procedures is believed to be sufficient to docket and monitor maintenance fee due dates and payments and employment of additional safeguards are not believed to be required.

15. In the present case, failure to pay the maintenance fee was the result of a clerical error which resulted from a human error. Maintenance fee due dates were incorrectly docketed upon issuance of the subject patent. The grant year of the Reissue patent was entered into the docketing software as the basis for maintenance fee due dates rather than the grant date of the original patent, U.S. Patent No. 5,614,737 issued March 25, 1997. Maintenance fees were docketed for September 25, 2004, September 25, 2008, and September 25, 2012, and were reported as such to the client (a letter dated September 30, 2004, reporting issuance of Letters Patent to the client is attached hereto as Exhibit A). Due to limitations of the docketing and maintenance fee software, it is not presently possible to identify the specific docketing clerk who entered incorrect base date for maintenance fee due date calculation. The prosecution of the parent patent was not handled by Blank Rome and the docketing system did not include a record for the parent patent.

16. The correct 3.5 year maintenance fee due date of September 25, 2000, was not docketed in IPMaster and the maintenance fee software module. Thus, the docketing and maintenance fee software did not generate a reminder regarding the 3.5 year maintenance fee due date. As a result of this clerical error in entering the base date for maintenance fee due date

calculation, the 3.5 year maintenance fee was not paid and the maintenance fee clerk and docketing staff were not alerted to the failure to make a payment.

17. The error in docketing maintenance fee due dates was noted and corrected subsequent to the 3.5 year maintenance fee due date. As noted above, it was standard practice at the time of the above error to reconcile and resolve anomalies, inconsistencies, questions and the like prior to taking action, and before any due date was cleared from the docket. In the present case, a clerical error occurred in that the docketing record and maintenance fee file were not fully reviewed when the docketing error in the 3.5 year maintenance fee due date was noted and corrected. The clerical error resulted in failure to note nonpayment of the 3.5 year maintenance fee at the time the docketing error was corrected. Due to limitations of the docketing and maintenance fee software, it is not presently possible to identify the specific employee who corrected the maintenance fee due dates and failed to review the full docketing record and maintenance fee file.

18. The firm's docketing and maintenance fee software generated a due date reminder in advance of the 7.5 year maintenance fee due date of September 25, 2004. Believing the patent to be in force based on the firm's docketing and maintenance fee records, authorization to charge the 7.5 year maintenance fee to Deposit Account No. 23-2185 was provided to the Office on August 27, 2004, and receipt of said authorization acknowledged by the Office. Funds sufficient to process the 7.5 year maintenance fee were available in the deposit account on August 27, 2004. A copy of the authorization and acknowledgement is attached as Exhibit B. Since the 7.5 year maintenance fee was timely paid with sufficient funds in the deposit account, a maintenance fee statement and deposit account activity for the subject patent was not monitored in accordance with the firm's procedures.

19. The firm's docketing and maintenance fee software generated a due date reminder in advance of the 11.5 year maintenance fee due date of September 25, 2008. On September 19, 2008, in preparation for payment of the 11.5 year maintenance fee, Brandon Lloyd, the current maintenance fee clerk, made a review of the entire maintenance fee file beyond the normal review procedure and noted that paperwork, e.g., a transmittal form, for the 3.5 year maintenance fee was not present in the maintenance fee file. He notified the undersigned of the absence of such paperwork.

20. Upon a review of the firm's maintenance fee record and Office records beyond the normal review procedure, including maintenance fee statements, PAIR status and Deposit Account records, I determined that the PAIR record identified the subject patent as a "Patented Case", maintenance fee statements for 3.5 and 7.5 years were not available and the Office did not charge the 7.5 year maintenance fee to the Deposit Account as requested. Upon determination that the 3.5 year and 7.5 year maintenance fees had not been paid, a petition for acceptance of the maintenance fees as being unavoidably delayed was filed promptly on September 25, 2008.

21. Although it is not possible to identify the specific employee(s) responsible for the above-described errors, based on my IP experience and familiarity with the firm's docketing and maintenance fee procedures, there is no other plausible explanation for the delay in payment of the 3.5 year and 7.5 year maintenance fees than that given above.

Dated: February 9, 2009

Respectfully,

By 

Andrew H. Yost

IP Administrator

BLANK ROME LLP

BLANK ROME COMISKY & MCCAULEY

Counselors at Law

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Email: 202-463-6915
greenbaum@blankrome.com

November 30, 2000

VIA FEDERAL EXPRESS

Harshad Mehta, Ph.D.
President and CEO
Silicon Power Corporation
252 Welsh Pool Road
Exton, Pennsylvania 19341

Re: Reissue of USSN 08/504,335
Dante E. Piccone
Our Ref. 105773.00103

Dear Harshad:

Further to our letter dated March 24, 2000, enclosed is the Official Letters Patent
(*Reissued Patent No. Re. 36,770, Issued July 11, 2000*), together with four (4) soft copies.

Maintenance fees will become due on September 25, 2004, September 25, 2008 and
September 25, 2012. We will notify you six months in advance of your payment due date.

Very truly yours,

BLANK ROME COMISKY & MCCAULEY LLP


Michael C. Greenbaum

MCG/pab
Enclosures: Letters Patent and 4 Soft Copies

H:\105773\00103\REISSUE\CORR\Reissue Letters Patent.wpd

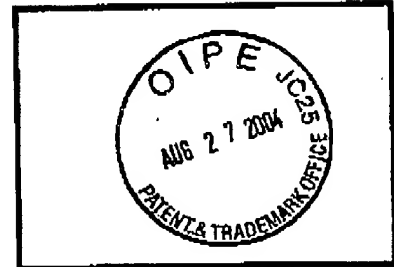
The Farragut Building, 900 17th Street, N.W., Suite 1000 • Washington, DC 20006 • 202.530.7400 • Fax: 202.463.6915

600 New Hampshire Ave., N.W., Washington, DC 20037
Phone: 202.772.5800 • Fax: 202.572.8398

August 27, 2004

**THE OFFICIAL DATE STAMP HEREON BY THE U.S.
PATENT AND TRADEMARK OFFICE WILL ACKNOWLEDGE
RECEIPT OF THE FOLLOWING:**

- Fee Address Form
- Maintenance Fee Transmittal (duplicate)



Patent Number	Grant Date	Application Number	Attorney Reference
5608167	3/4/1997	08/390980	000364.0046
6204396	3/20/2001	09/472596	110644.0101
6248502	6/19/2001	09/631975	000529.0007
6249700	6/19/2001	09/449444	001309.0052
RE36770	7/11/2000	09/273567	105773.0132

Patent Number	Grant Date	Application Number	Attorney Reference
		2,800,007	

Grant Date Application Number

DOS 773.0132
00569.0040
110644.0101

00569.0007
00309.0052
2004 RES

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BLANK ROME

600 New Hampshire Ave., N.W., Washington, DC 20037
Phone: 202.772.5800 • Fax: 202.572.8398

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August 27, 2004

Assistant Commissioner for Patents
Box M Fee
Washington, D.C. 20231



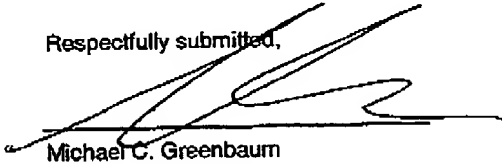
Enclosed herewith is the payment of the maintenance fee(s) for the listed patent(s).

- ☐ A check in the amount of _____ for the full payment of the maintenance fee(s) and any necessary surcharge on the following patents is enclosed.
- ☒ The Commissioner is hereby authorized to charge \$4,955.00 to cover the payment of the fee(s) indicated below to Deposit Account No. 23-2185.
- ☒ The Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No. 23-2185.

Patent Number	Grant Date	Application Number	Attorney Reference	For	Fee Status	Maintenance Fee	Surcharge
5608167	3/4/1997	08/390980	000364.0048	Year 8 Tax	LARGE ENTITY	\$2,080.00	\$0.00
6204396	3/20/2001	09/472596	110644.0101	Year 4 Tax	SMALL ENTITY	\$455.00	\$0.00
6248502	6/19/2001	09/631975	000529.0007	Year 4 Tax	SMALL ENTITY	\$455.00	\$0.00
6249700	6/19/2001	09/449444	001309.0052	Year 4 Tax	LARGE ENTITY	\$910.00	\$0.00
RE36770	7/11/2000	09/273567	105773.0132	Year 8 Tax	SMALL ENTITY	\$1,045.00	\$0.00
Subtotals:						\$4,955.00	
Total Payment						\$4,955.00	

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Respectfully submitted,


Michael C. Greenbaum
Attorney for applicant
Registration number: 28,419



UNITED STATES PATENT AND TRADEMARK OFFICE

BLANK ROME LLP

DEC 11 2008

COUNSELORS AT LAW

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 7

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON DC 20037

In re Patent No. RE36770
Issued: July 11, 2000
Application No. 09/273,567
Reissue of Patent No. 5,614,737
Original Issued: March 25, 1997
Attorney Docket No. 105773.00110

ON PETITION

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105773-0132
DEC 12 2008

Action Due
Due Date
Pg. for Reconsideration
2/8/09

This is a decision on the petition under 37 CFR 1.378(b), filed September 25, 2008, to reinstate the above-cited patent.

The petition is dismissed.

The original patent issued March 25, 1997. The 3.5 year maintenance fee could have been paid from March 25, 2000, through September 25, 2000, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from September 26, 2000 to March 25, 2001. The maintenance fee was not paid. Accordingly, the patent expired at midnight on March 25, 2001.

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Commissioner that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable. The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b).

Opinion

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.¹

¹The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee . . . at any time . . . if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F. Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion Rule 36, 937 F.2d 623 (Fed Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d agencies' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or

However, "[t]he question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."² Nonawareness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP, or the Official Gazette notices does not constitute unavoidable delay.³ The statute requires a "showing" by petitioner, therefore; petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Petitioner is responsible for possessing knowledge of the need to pay maintenance fees and the due dates for such fees. Petitioner is responsible for instituting a reliable docketing system to remind him or her when maintenance fees become due.

Petitioner is responsible for having knowledge of the need to pay maintenance fees and knowing when the fees are due.⁴ The Office has no duty to notify a patentee of the requirement to pay maintenance fees or to notify patentee when a maintenance fee is due.⁵ Even if the Office were required to provide notice to

ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F. 3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1781 (Fed. Cir. 1995) (Citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990); Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P. Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullah, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullah, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat 31, 32-33 (1887)).

²Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

³See Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable delay"); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (plaintiffs, through their counsel's action, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

⁴Nonawareness of PTO statutes, PTO rules, the MPEP, or Official Gazette notices, which state maintenance fee amounts and dates they are due does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs, through their counsel's actions, or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Petitioner must act as a reasonable and prudent person in relation to his most important business. Upon obtaining the patent, a reasonable and prudent person, in relation to his most important business, would become familiar with the legal requirements of that business, in this case, the requirement to pay maintenance fees. In addition, a reasonable and prudent individual would read the patent itself and thereby become aware of the need to pay maintenance fees and the fact that such fee amounts are sometimes changed by law or regulation.

⁵Congress expressly conditioned §§ 133 and 151 [of the United States Code] on a specific type of notice, while no such notice requirements are written into § 41(c) ... [T]he Commissioner's no timely-notice interpretation." Ray v. Comer, 1994 U.S. Dist.

applicant of the existence of maintenance fee requirements, such notice is provided by the patent itself.⁶

A reasonable and prudent person, aware of the existence of maintenance fees, would not rely on maintenance fee reminders or on memory to remind him or her when payments would fall due several years in the future. Instead, such an individual would implement a reliable and trustworthy tracking system to keep track of the relevant dates.⁷ The individual would also take steps to ensure that the patent information was correctly entered into the tracking system.

Application of the unavoidable standard to the present facts

In the instant petition, petitioner argues that the above-cited patent should be reinstated because the delay in paying the 3.5-year maintenance fee was unavoidable and resulted from a clerical error.

The argument has been considered, but is not persuasive as the showing made in the petition is incomplete.⁸ Further to this point, Section 711.03(c)(2) provides, in pertinent part that:

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*,

LEXIS 21478, 8-9 (1994), *aff'd on other grounds Ray v. Lehman*, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995) (Citing *Rydeen v. Quigg*, 748 F. Supp. 900, 905 (1990), *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 81 L. ed. 2d 694, 104 S. Ct. 2778 (1984)). "The Court concludes as it did in *Rydeen*, that as a constitutional matter, 'plaintiff was not entitled to any notice beyond publication of the statute.' *Id.* at 3 (citing *Rydeen v. Quigg*, 748 F. Supp. at 906, *Texaco v. Short*, 454 U.S. 516, 536, 70 L. Ed. 2d 738, 102 S. Ct. 781 (1982)).

The Patent Office, as a courtesy tries to send maintenance fee reminders and notices of patent expiration to the address of record. However, the failure to receive the reminder notice, and the lack of knowledge of the requirement to pay the maintenance fee, will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. See MPEP 2575, 2540, 2590. Petitioner does not have a right to a personalized notice that this patent will expire if a certain maintenance fee is not paid, as the publication of the statute was sufficient notice. See *Rydeen v. Quigg*, 748 F. Supp. 900, 907 (1990). the ultimate responsibility for keeping track of maintenance fee states lies with the patentee, not the USPTO. Since the mailing of Notices by the Office is completely discretionary and not a requirement imposed by Congress, accepting an argument that failure to receive a Notice is unavoidable delay would result in all delays being unavoidable should the Office discontinue the policy. All petitions could allege non-receipt of the reminder, and therefore all petitions could be granted. This was clearly not the intent of Congress in the creation of the unavoidable standard.

⁶ See *Ray v. Lehman*, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters of Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

⁷ 37 CFR 1.378(b)(3) precludes acceptance of a late maintenance fee for a patent unless a petitioner can demonstrate that steps were in place to monitor the maintenance fee. The federal Circuit has specifically upheld the validity of this regulation. *Ray v. Lehman*, 55 F.3d 606, 609; 34 USPQ2d (BNA) 1786 (Fed.Cir. 1995). In *Ray v. Lehman*, petitioner claimed that he had not known of the existence of the maintenance fees and therefore had no steps in place to pay such fees. The petitioner therefore argues that the PTO's regulation, 37 CFR 1.37(b)(3), supra, arguing that it "creates a burden that goes well beyond what is reasonably prudent." We disagree. The PTO's regulation merely sets forth how one is to prove that he was reasonably prudent, i.e., by showing what steps he took to ensure that the maintenance fee would be timely paid, and the steps taken in seeking to reinstate the patent. We do not see these requirements additional to proving unavoidable delay, but as the very elements of unavoidable delay." *Id.*

673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

The instant petition states that a clerical error in the performance of a docketing function resulted in non-payment of the 3.5-year maintenance fee. Petitioner does not, however, attribute this error to any employee in particular. A successful petition under 37 CFR 1.378(b) under the circumstances presented would require petitioner to identify the employee to whom the clerical error may be attributed and detail the training and experience of the employee so as demonstrate that reliance on the employee represented the exercise of due care. Petitioner offers only sparse details as to the business routine in place for ensuring timely payment of the maintenance fee. If petitioner chooses to file a renewed petition, it must be accompanied by comprehensive and exhaustive evidence that supports petitioner's contention that a clerical error resulted in the unavoidable delay in paying the 3.5-year maintenance fee.

Petitioner is further advised that a statement is required from all persons with direct knowledge of the cause of unavoidable delay. Section 2590 of the *Manual of Patent Examining Procedure* (MPEP) provides that, among other requirements, a petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

A statement from the employee charged with handling the payment of the maintenance fee is, therefore, required. Petitioner is cautioned that it will be difficult to grant a petition for unavoidable delay without a statement from the employee that would have first-hand knowledge the circumstances that resulted in the delay.

Petitioner is reminded that a successful petition under 37 CFR 1.378(b) requires petitioner to show that the entire delay in paying the maintenance fee was unavoidable--beginning from the due date for the maintenance fee until the filing of a grantable petition. It is noted that petitioner allegedly attempted to pay the 7.5-year maintenance fee in August of 2004. Petitioner maintains that, relative to both the 3.5-year and 7.5-year maintenance fees, petitioner did not receive a Notice of Patent Expiration or a notice indicating the 7.5-year maintenance fee was not accepted because of the failure to pay the 3.5-year maintenance fee. The failure to receive a Notice of Patent Expiration is not a cause for unavoidable delay as petitioner is made of aware of the need to pay the maintenance fee and the schedule for

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doing the same in the original Letters of Patent. Arguably, petitioner may have been made aware of the expiration of the patent had petitioner contacted the USPTO to determine if the 7.5-year maintenance fee had been accepted—which is reasonable to expect where the maintenance of the patent being treated as petitioner's most important business. The renewed petition must explain how the patent be expired for six years without discovery if the maintenance of the patent was petitioner's most important business.

Petitioner's Current Options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision.⁸ The petition for reconsideration should be titled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration for this decision must be accompanied by a non-refundable petition fee of \$400.00 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. It is, therefore, extremely important that petitioner supply any and all relevant information and documentation with the request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence "to show" that the delay was unavoidable. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

By facsimile: (571) 273-8300
Attn: Office of Petitions

A reasonable and prudent person would not rely on maintenance fee reminders from the Office for two reasons. First, the Office has indicated that such reminders are a mere courtesy and has reserved the right to discontinue such reminders at any time. second, such reminders may be lost in the mail. A reasonable and prudent person, in regard to his most important business would not rely solely on reminders that the Office may or may not send which may or may not be lost in the mail.

⁸No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is not a final agency action within the meaning of 5 U.S.C. § 704.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.



Kenya A. McLaughlin
Petition Attorney
Office of Petitions